REMARKS

This paper is responsive to an Office Action mailed January 10, 2008. Prior to this response, claims 1-33 were pending. After amending claims 22-23, claims 1-33 remain pending.

In Section 2 of the Office Action objections have been made to claim 23. In response, the claim has been amended.

In Section 3 of the Office Action claims 23-33 have been rejected under 35 U.S.C 101 as being directed to non-statutory subject matter. The Office Action states that the claims recite the physical characteristics of a form of energy, and that a claim reciting a signal encoded with functional descriptive material does not fall within any of the patent subject matter categories of 35 U.S.C. 101. The Office Action further states that the Applicant's specification describes code segments that can be stored in a processor-readable medium or transmitted by a computer data signal embodied in a carrier wave... [0018]. This rejection is traversed as follows.

In response, the Applicant notes that although the specification states that code segments may be transmitted by a data signal, the subject matter of claim 22 is "computer readable medium". To further clarify the claimed invention, claim 23 has been amended to recite a --computer readable tangible medium--. As noted in the above-cited section of the specification, code segments can be stored in a processor-readable medium. The claim has also been amended to recite that computer program code is *stored* in the computer readable medium. A computer-readable medium is an item of manufacture, and falls under one

of the four enumerated categories of patentable subject matter described in 35 U.S.C. 101. As would be understood by one with skill in the art, a computer readable medium can be manufactured by creating magnetic variances in the recording medium.

Further, "(t)he question of whether a claim encompasses statutory subject matter should not focus on <u>which</u> of the four categories of subject matter a claim is directed to – process, machine, manufacture, or composition of matter – [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristic of the subject matter, in particular, its practical utility" *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602.

Since the computer code is used to perform configuration operations, without the requirement of a reboot, the claimed invention is "useful, tangible, and concrete", which also meets the requirements for 35 U.S.C. 101.

As noted in the MPEP 2107.02 IV - To properly reject a claimed invention under 35 U.S.C. 101, the Office Action must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide sufficient evidentiary basis for factual assumptions relied upon in making the *prima facie* showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975). "Accordingly, the PTO must do more than merely question operability – it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability." If the Office Action cannot develop a proper *prima facie* case and provide evidentiary support under 35 U.S.C. 101, a rejection on this ground should not be imposed. See, e.g., *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The Office Action merely states that the claimed invention recites non-statutory natural phenomena application, without making a *prima facie* case, or evidentiary support that the claimed invention lacks utility.

The claimed invention is tied to the physical world by being embodied in a tangible medium, and has practical utility. For these reasons, and because a *prima facie* case for rejection has not been supported, the Applicant respectfully requests that the rejection be removed.

In Section 5 of the Office Action, claims 1-33 have been rejected under 35 U.S.C. 103(a) with respect to Nandi et al. ("Nandi"; US 7,272,674) in view of Klotz et al. ("Klotz"; US 2004/0054776). With respect to claims 1, 15-16, and 32, the Office Action acknowledges that Nandi fails to disclose blocking subsequent data flows through the selected instance of an adaptive driver, and blocking information requests to the selected instance. The Office Action states that Klotz discloses these features and that it would have been obvious to combine the teachings of Klotz with Nandi, with the motivation being to prevent corruption conditions while configuring HBA. This rejection is traversed as follows.

Nandi discloses a system that uses reservation commands so that the port of a shared device to be used as the active port by a host computer system coupled to the shared device (Abstract). The Office Action states that Nandi discloses reinitializing the selected instance without booting the server, citing col. 5, ln. 39-64 and col. 6, ln. 33-54.

Col. 5, ln. 39-64 describes a device discovery layer 325 (see Fig. 3) that discovers attributes of a storage device, such as multipath

attributes of disks and disk arrays. Col. 6, ln. 33-54, states that the device discovery layer 325 can be used to discover the active port of a relevant storage device. The cited section also describes SCSI-3 persistent reservation keys that are used to encode host to LUNs connectivity information (path attribute).

With respect to claims 1, 12, and 23, although the above-cited sections disclose path attribute discovery processes, the Applicant respectfully submits that these passages do not disclose the limitation of reinitializing a selected instance without rebooting, even though the claims recite that the adapter driver instances correspond to adapter ports.

Generally, Klotz discloses a method for determining bidirectional data traces, network topology, and network protocols (Abstract). In [0125] Klotz discloses pending exchange counters that are used to track the state of open conversations for multiple protocols. For a pair of ports an immediate reading can determine how much work has been requested and how fast it is being completed. If a target supplies a Queue Full message, the method may attempt to limit ("throttle") pending I/Os.

With respect to claims 1, 12, and 23, although the cited passage appears to describe the limiting of data flow to targets having full buffers, no mention is made of blocking data flow through, or requests to an adapter driver instance in response to changing a selected instance. Further, no mention is made of blocking in the context of rebooting, or not needing to reboot a server.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Nandi would have been obvious to one of ordinary skill in the art in light of Klotz. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of

ordinary skill to modify the prior art reference or the combine prior art
references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the
rejection must articulate the following criteria to resolve the *Graham*
factual analysis:

(1) a finding that there was some teaching, suggestion or
motivation, either in the references themselves or in the knowledge
generally available to one of ordinary skill in the art, to modify the
reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of
success; and

(3) whatever additional findings based on the Graham
factual inquiries may be necessary, in view of the facts of the case under
consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis
criteria, the Klotz reference has been combined with Nandi based upon
the assumption that the combination discloses every limitation recited in
Applicant's claims 1, 12, and 23. However, neither Nandi nor Klotz
discloses the limitation of reinitializing a selected instance without
rebooting. Neither reference discloses the limitations of blocking data
flow through, or requests to an adapter driver instance in response to
changing a selected instance. Therefore, even if elements from Klotz are
combined with Nandi, that combination does not explicitly disclose every
limitation of claims 1, 12, and 23. Claims 2-11, dependent from claim 1,
claims 13-22, dependent from claim 12, and claims 24-33, dependent from
claim 23, enjoy the same advantages.

The Office Action states that it would have been obvious to apply the features of Klotz with Nandi to prevent corruption conditions while configuring HBA. However, the motivation to prevent corruption does not suggest the blocking of data through, and requests to a selected instance corresponding to an adapter port. Neither does the prevention of corruption suggest changing a selected instance with rebooting the server. In fact, this motivation appears to have nothing to do with a system and method for reselecting instances without a reboot. A *prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Nandi reference. However, there is nothing in the Klotz reference that suggests an instance reselection process that can be accomplished with a reboot.

Neither does the obviousness rejection provide evidence that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. "(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, "the evidence" of motive

will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied". *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to reselect an instance with rebooting the server.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if an expert were given the Nandi and Klotz references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.
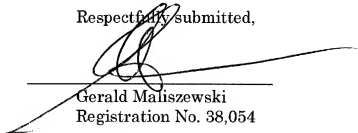
In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Klotz and Nandi does not explicitly disclose every limitation of claims 1, 12, and 23. Neither has a case been supported that Nandi can be modified to supply the missing limitations in view of Klotz, or what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 1-33 be removed.

Applicant asserts that the claims are patentable over the references made of record. It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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